

## **REMARKS**

Claims 1-92 are pending in this application. Claims 14-78 and 83-92 have been withdrawn. Claims 1, 3, 4, and 5 have been rejected under 35 U.S.C. § 102(e). Claims 2, 6-13, and 79-83 have been rejected under 35 U.S.C. § 103(a).

Claims 1-5, 11-13 and 79 have been amended with no new matter having been added. Claims 14-78 and 83-92 have been canceled. Claims 93-108 have been added.

### **Rejections under 35 U.S.C. § 102(e)**

Claims 1, 3, 4, and 5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,277,648 to Colpan (hereinafter “Colpan”). Applicants traverse this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference. MPEP §2131. Applicants believe that Colpan does not anticipate the present invention because it does not set forth at least one of the claim elements of independent claim 1.

Independent claim 1 has been amended to clarify the invention. In particular, claim 1 has been amended such that the conduit extends from an opening on the first surface to an opening on the second surface and such that the extraction device mates with the carrier, closes the first opening, seals the first opening to prevent fluid flow, and forms a reservoir. Colpan does not teach, suggest or disclose a carrier closing off the first end of the conduit and sealing it to prevent fluid flow.

Specifically, the Office refers to the cylindrical hollow body (40) in Colpan as a sample carrier, and the open space formed within (1) as equivalent to a conduit. However, Colpan teaches that the cylindrical hollow body (40) functions by having fluid pass through it. For example, Colpan shows a filtration unit (70) disposed within the cylindrical hollow body (40) and teaches the use of this combination to filter a sample, causing fluid flow into the open space of extraction column (1). Nowhere in Colpan is there a suggestion of adding fluid from another place than through the hollow cylindrical hollow body (40), nor does Colpan suggest preventing fluid from flowing through the filtration unit within the hollow body. Not only does Colpan not teach closing off this

end of the conduit, but sealing of conduit by a carrier would render impossible the only process that is described, which is fluid flow through the filtration unit (70) into space formed within (1). Colpan even refers to the cylindrical hollow body (40) as having inlet and outlet openings (col. 1, lines 40-41), indicating that it is used for fluid flow. Thus, Colpan does not teach, suggest, or disclose the element of closing off an end of the conduit to prevent fluid flow and therefore does not anticipate claim 1 as amended.

Dependent claims 3, 4, and 5 were also rejected as anticipated by Colpan. Applicants believe that these claims are now allowable as being dependent on an allowable claim for the reasons described herein. For these reasons, applicants believe that claim 1 and its respective dependent claims are now allowable.

#### **Rejections under 35 U.S.C. § 103(a)**

Claims 2, 6-13, and 79-82 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Colpan in view of U.S. Patent 5,985,085 to Baer et al. (hereinafter “Baer”). Applicants traverse this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP §2143.

#### **Claim 2**

Claim 2 is dependent on amended claim 1. Claim 2 has been amended to be consistent with respect to its reference to claim 1, by referring now to an extraction unit which comprises, in part, an extraction device. Applicants believe that claim 2 is now allowable as being dependant on allowable claim 1 as amended.

#### **Claims 6-10**

The first criterion listed above is for a suggestion or motivation to modify the references or to combine the teachings. Claims 6-10 include a carrier having a transfer

film, where at least a portion of the transfer film is disposed within the reservoir. Nowhere in Colpan is the incorporation of a transfer film into Colpan's filtration device disclosed, taught, or suggested.

In addition, even if there were a mention of transfer film in Colpan, there is no suggestion to dispose something such as a transfer film in the reservoir. Even with respect to samples, Colpan only discusses putting a sample on top of the filter layer (col. 3, line 31-32), and there is nothing disclosed in Colpan that is analogous to the transfer film.

Not only is there no reference to a transfer film in Colpan, but if a transfer film were used in place of a filter unit (70), it would render impossible the purpose of the device as described by Colpan because transfer films as described by Baer are generally not permeable to fluids and would block fluid flow that Colpan describes, rendering Colpan's device useless. Hence, there could be no reasonable expectation of success.

In addition, while Baer discloses a transfer film, it does not disclose, teach or suggest an extraction device with a conduit extending between the carrier receiving portion and a second end of an extraction device, thus there is no suggestion or motivation in Baer to modify or combine the transfer film with the filtration column of Colpan. Therefore, the rejection under 35 U.S.C. §103(a) should be withdrawn with respect to claims 6-10.

#### Claims 11-13

Independent claim 11 has been amended to clarify the invention. In particular, claim 11 now specifies that the at least a portion of the carrier includes an extending feature, and at least a portion of the extending feature is sealed from the reservoir. The Office states that Baer teaches a stand-off portion. However, neither Baer nor Colpan disclose, teach, or suggest to seal at least a portion of the stand-off from the reservoir. Because this claim element is not disclosed, taught, or suggested, claim 11 and its respective dependent claims are non-obvious and allowable.

Also, the third criterion listed above states that the prior art references must teach or suggest all the claim limitations in order to establish a prima facie case of obviousness. MPEP §2143. Applicants believe that this criterion is not met with respect to claims 11-

13 and maintain that the prior art references do not disclose, teach or suggest all of the claim limitations. For example, the prior art references do not disclose, teach or suggest adapting an extraction device such that an extending feature is sealed from the reservoir. While Baer teaches a stand-off, which can be a type of extending feature, Baer does appreciate the desirability of sealing a stand-off from a reservoir, and therefore, not all of the claim limitations are taught or suggested in the references.

Dependent claim 12 has been amended to specify that non-specifically transferred material is on the portion of the extending feature sealed from the reservoir. Dependent claim 13 has been amended to specify that the extending features of claims 11 and 12 comprise one or more stand-offs or spacers. Applicants believe these claims are now allowable as dependent on allowable claim 11.

Therefore, the rejection under 35 U.S.C. §103(a) should be withdrawn with respect to claims 11-13.

Claims 79-83

Independent method claim 79 has been amended to clarify the invention. In particular, claim 79 specifies that the extraction device has a conduit having a first opening and a second opening, that the mating of the extraction device and the carrier closes the first opening, and that the step of providing fluid to the reservoir to extract matter from the transfer film occurs via the second opening in the conduit. The third criterion listed above states that the prior art references must teach or suggest all the claim limitations in order to establish a *prima facie* case of obviousness. MPEP §2143. Applicants believe that this criterion is not met with respect to claims 79-83 and maintain that the prior art references do not disclose, teach or suggest all of the claim limitations. For example, neither reference discloses, teaches, or suggests an extraction device having a conduit with a first opening and a second opening and mating the extraction device to a carrier to close the first opening. In addition, neither Colpan nor Baer disclose, teach, or suggest providing fluid via a second opening in a conduit to extract matter from a transfer film.

Additionally, with respect to the first criterion listed above, there is no suggestion or motivation in Colpan to combine Colpan's filtration device with a transfer film.

Colpan does not disclose, teach or suggest a transfer film, and there is nothing within Colpan that would suggest the use of a transfer film with Colpan's device. There is nothing disclosed in Colpan that is analogous to a transfer film. Furthermore, there is nothing within Colpan that would suggest forming a reservoir with a transfer film. Therefore, the rejection under 35 U.S.C. §103(a) should be withdrawn with respect to claims 79-83.

In view of the foregoing remarks, applicants respectfully submit that the application is in a condition for allowance, and action toward that end is earnestly solicited. The Office is invited to contact the applicant's representative at the number below to facilitate prosecution of this application.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time.

Respectfully submitted,

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